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Via Express Mail 721158493US

PTO/SB/64 (07-05)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT
ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

Docket Number (Optional)

37291.3

First named inventor: Vincent P. Stanton

Application No.: 10/043,615

Art Unit: 1637

Filed: January 8, 2002

Examiner: Jezia Riley

Title: Base-Modified Nucleotides And Their Use For Polymorphism Detection

Attention: Office of Petitions

Mail Stop Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

FAX (571) 273-8300

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus an extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional.

1. Petition fee

☒ Small entity-fee \$ 750 (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☐ Other than small entity - fee \$ _____ (37 CFR 1.17(m))

2. Reply and/or fee

A. The reply and/or fee to the above-noted Office action in the form of Petition To Revive And Response To Non-Final Office Action (identify type of reply):

- ☐ has been filed previously on _____.
- ☒ is enclosed herewith.

B. The issue fee and publication fee (if applicable) of \$ _____.

- ☐ has been paid previously on _____.
- ☐ is enclosed herewith.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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3. Terminal disclaimer with disclaimer fee

- ☐ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.
- ☒ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ 65 for a small entity or \$ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

 23 August 2005
Signature Date

Bernard F. Rose 42,112
Typed or printed name Registration Number, if applicable

One Maritime Plaza, Suite 300 (415) 954-0200
Address Telephone Number

San Francisco, CA 94111-3492
Address

- Enclosures: ☒ Fee Payment
- ☒ Reply
- ☒ Terminal Disclaimer Form
- ☐ Additional sheets containing statements establishing unintentional delay
- ☒ Other: Petition for Extension of Time

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

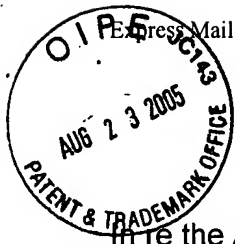
☐ Deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

☐ Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office as (571) 273-8300.

8/23/05 Rebecca M. Klits
Date Signature

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Rebecca M. Klits
Typed or printed name of person signing certificate



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PATENT
10/043,615

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

STANTON, Vincent P.

Serial No.: 10/043,615

Filed: 8 January 2002

For: BASE-MODIFIED

**NUCLEOTIDES AND THEIR USE FOR
POLYMORPHISM DETECTION**

Group Art Unit: 1637

Examiner: Riley, Jezia

Mail Stop Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

PETITION TO REVIVE AND RESPONSE TO NON-FINAL OFFICE ACTION

Sir:

With regard to the final Office Action mailed 1 October 2004, please take the following actions and consider the remarks below.

This response accompanies a petition to revive the current application based on unintentional abandonment. Applicants' counsel was in the process of changing firms and on jury duty in a 7-week capital case at the same time and thereby unintentionally allowed the current application to go abandoned.

IN THE SPECIFICATION:

Please amend the specification as shown on the separate page that follows.

AMENDMENT TO THE SPECIFICATION

RELATED APPLICATIONS

[0002] [0001] This application is a continuation-in-part of co-pending U.S. Serial No. 09/394,467 to Stanton, Wolfe and Verdine, filed September 10, 1999, entitled, "A METHOD FOR ANALYZING POLYNUCLEOTIDES." Ser. No. 09/394,467 in turn claims the benefit of U. S. Provisional Patent Application Serial No. 60/102,724, filed October 1, 1998, also entitled, "A METHOD FOR ANALYZING POLYNUCLEOTIDES." Both are incorporated by reference in their entireties, including drawings and tables, as if fully set forth herein.

FIELD OF THE INVENTION

[0004] [0002] The present invention relates generally to organic chemistry, analytical chemistry, biochemistry, molecular biology, genetics, diagnostics and medicine. In particular, it relates to base-modified –nucleotides and methods for their use for the detection of polymorphisms (SNPs).

REMARKS

Claims 1 – 20 are presently before the examiner. Claims 1-3, 19 and 20 are rejected under the judicially created doctrine of double patenting, claims 4 – 12 are objected to as being dependent on a rejected base claim and claims 13 – 18 are allowed.

Priority claim

The examiner objects to the form of the priority claim in that it was not presented as the very first paragraph/sentence of the application and if did not contain the status of the priority application.

Applicants' response

Applicants have amended the specification by interchanging Paragraphs [0001] and [0002] and amending the priority claim to indicate that, at the time of filing of the current application, the priority application was co-pending.

Applicants believe that the above changes in the priority claim are trivial, that the priority claim was in fact legally perfected at the time of filing of the current application and therefore that no petition to accept an unintentionally delayed claim for priority or petition fee should be required.

Double patenting

The examiner has issued a non-statutory double patenting rejection of claims 1 – 3, 19 and 20 in that, in the examiner's opinion, these claims are unpatentable over claims 1- 4, 7 – 11, 13 – 15, 19, 20, 68 and 69 of U.S. Pat. No. 6,566,059. Furthermore the examiner objects to claims 4 – 12 of the current application as being dependent from a rejected base claim.

Applicants' response

As noted by the examiner, a non-statutory double patenting rejection may be overcome by the filing of a terminal disclaimer in compliance with 37 CFR 1.321(c). Such a terminal disclaimer accompanies this response thus rendering the rejection of claims 1 – 3, 19 and 20 and the objection to claims 4 – 12 moot.

CONCLUSION

Based on the above amendment of the specification and the concurrent filing of a terminal disclaimer herewith, applicants believe that the application is in condition for allowance and respectfully requests that it be passed to issue.

The Commissioner is authorized to charge any fee(s) due with the response to Squire Sanders and Dempsey, L.L.P. Deposit Account No.07-1850.

If the Examiner has any questions or concerns, the Examiner is invited to telephone the undersigned attorney at (415) 954-0200.

Date: August 23, 2005

Squire, Sanders & Dempsey L.L.P.

One Maritime Plaza, Suite 300

San Francisco, CA 94111-3492

(415) 954-0200

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Bernard F. Rose', with a stylized flourish at the end.

Bernard F. Rose

Reg. No. 42,112